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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,)
Plaintiff,)
vs.) No. 99cv2668 H (AJB)
VYSIS, INC.,)
Defendant.)

The confidential deposition of WALTER KING, Ph.D., called as a witness for examination, taken pursuant to the Federal Rules of Civil Procedure of the United States District Courts pertaining to the taking of depositions, taken before ANDREA L. CARTER, a Notary Public within and for the County of Cook, State of Illinois, and a Certified Shorthand Reporter of said state, CSR No. 84-3722, at Suite 205, 2111 Butterfield Road, Downers Grove, Illinois, on the 18th day of April, A.D. 2001, at 9:01 a.m.

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1 you, Drs. Halbert, Lawrie and Collins?

2 A. How many subject matters?

3 Q. Yes. When we get done with this
4 inquiry, I want you to be able to tell the ladies
5 and gentlemen of the jury absolutely everything you
6 can remember being discussed during the course of
7 that meeting. But what I wanted to try to do to
8 ease it for you hopefully, if that's the case, is
9 start with the high level subject matters.

10 From a high level perspective, what were
11 the discussion topics addressed during this
12 meeting?

13 A. I think that at the highest level we
14 were looking for amplification methods that did not
15 involve PCR amplification.

16 Q. Why? Why were you looking for
17 amplification methods to begin with?

18 A. Well, at the time that we formed this
19 joint venture, Gene-Trak, Vysis did not have an
20 amplification method, a licensed amplification
21 method. So we felt that it was important that we
22 either seek one out or invent one or have, you
23 know, the ability to demonstrate that we have an
24 amplification method that was different than PCR.

1 amplification could have ranged from signal
2 amplification to probe amplification as well; is
3 that correct?

4 MR. BANKS: Objection as to time.

5 BY THE WITNESS:

6 A. I am not aware that anybody was working
7 on probe amplification.

8 BY MR. SWINTON:

9 Q. Okay. So the purpose -- the general
10 purpose of the discussion as I understand it that
11 took place at Gene-Trak among the four doctors was
12 to identify -- in general identify an
13 amplification technique that would amplify low
14 concentrations of target nucleic acids in a sample,
15 correct?

16 A. Yes.

17 Q. And as I understand your testimony, you
18 wanted to find a technique that was different from
19 PCR, correct?

20 A. Yes.

21 Q. Why? Why did you want to find something
22 that was different than PCR?

23 A. Well, I wasn't involved in the business
24 development part. I think that I was asked to put

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1 correct?

2 A. I am not sure. I am not sure that
3 that's true.

4 Q. Did you undertake any investigation in
5 order to verify your belief that you were the
6 sole -- one of the sole inventors of nonspecific
7 amplification techniques?

8 MR. BANKS: Object to form.

9 BY THE WITNESS:

10 A. No.

11 BY MR. SWINTON:

12 Q. So you don't know one way or the other?

13 A. No.

14 Q. Okay. At the time that the four of you
15 participated in the filing of the original
16 application that led to the issuance of -- that
17 disclosed amplification techniques that led to the
18 issuance of the '338 patent, did you intend to
19 claim the combination of target capture with PCR?

20 A. I don't have any recollection of that
21 being tied together with PCR.

22 Q. In fact, wouldn't -- based upon what I
23 have heard this morning, in fact wouldn't that have
24 been inconsistent with the -- the state of mind

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1 Q. Do you believe now that you invented the
2 combination of target capture and PCR?

3 A. Well, the -- these drawings don't
4 reflect that we combined it with PCR. So I guess I
5 am kind of confused. I -- we are talking about
6 the context of reversible target capture and the
7 methods of detection as stated here. So I am not
8 sure that we even talked about linking this with
9 PCR.

10 Q. Fair enough. And I don't -- let me
11 just close with it.

12 Is it fair to summarize that you don't
13 believe that now or at any time in the past that
14 you ever concluded that you invented the
15 combination of target capture with PCR?

16 A. I would have to do a literature search
17 and see whether there was any prior art. I don't
18 really even know to this date.

19 Q. Independent of prior art -- I am just
20 asking your state of mind what you thought.

21 Did you believe that you had come up
22 with the idea of combining target capture with PCR
23 at any time in the work that was associated with
24 the '338 patent?

1 A. Not specifically with PCR, no.

2 Q. Did any of the other three identified
3 inventors: Drs. Lawrie, Halbert or Collins ever
4 indicate to you that -- at any point in time, that
5 they ever believed that one of them had come up
6 with the idea of combining target capture with PCR?

7 A. No, I don't recall.

8 Q. Would you take a look at Exhibit 41.

9 Is this a copy of a portion of a lab
10 notebook that you maintained while you were at
11 Amoco?

12 A. Yes.

13 Q. And the -- I assume that these are
14 selected pages out of the lab notebook, not the
15 entirety of the book. At least that's what it
16 appears to me.

17 A. Yes.

18 Q. And the -- this laboratory notebook
19 encompasses the period of time November 16, 1985 to
20 October 24, 1986?

21 A. November 16th of '85 to October of '86,
22 yes.

23 Q. Would this notebook have followed you or
24 would you have taken this on the Gene-Trak or would

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1 Q. Well, you agree you are not changing any
2 of your prior testimony. You didn't talk about
3 target capture and specific amplification in your
4 meeting in 1986, correct? That's still your
5 testimony?

6 A. Yes.

7 Q. And as I recall, you didn't have any
8 further activity with respect to this patent
9 application before you signed the oath in 1997,
10 correct?

11 A. I didn't have any what?

12 Q. Did you didn't have any further
13 involvement with respect to any of the work that
14 related to this patent application until you signed
15 the oath in December of 1997, correct?

16 A. Yes.

17 Q. All right. And so you didn't talk
18 about -- you did not talk about the combination of
19 target capture and PCR in 1986. It doesn't come
20 up, you didn't have any other discussions about
21 that combination before you signed the oath in
22 December 1997, and the only specific amplification
23 technique you are aware of in December 1997 was
24 PCR, correct?

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1 A. Specific amplification?

2 Q. Yes.

3 A. Yes.

4 Q. So your testimony now is in December
5 1997 you believed your invention encompassed as to
6 specific amplification, the combination of target
7 capture and PCR. Is that your testimony now?

8 A. It encompasses that, yes.

9 Q. Why isn't there any disclosure in the
10 specification of the 338 patent that addresses PCR?

11 MR. BANKS: Objection, asked and answered.

12 MR. SWINTON: Well, I have got different
13 questions and different answers before.

14 MR. BANKS: You just asked it two minutes ago.
15 BY MR. SWINTON:

16 Q. Why isn't there any disclosure in the
17 specification of the '338 patent of PCR?

18 A. Well, you were asking me about line 2 to
19 see whether it includes specific and nonspecific
20 amplification very early on in this, and I said
21 that my reading of it was that did it include
22 specific amplification.

23 So why we didn't give an example of PCR?
24 I don't know. We were trying -- you said from a

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1 very high level meeting, the very high level
2 meeting I stated that we were trying to find ways
3 around just PCR the way it was being practiced. So
4 PCR was already on our mind. As to why we didn't
5 think of an example? We were trying to think of
6 these more novel examples.

7 Q. Didn't there come a time as you sat in
8 your office in December of 1997 you are reviewing
9 the application and you read all of the examples
10 you have that deal with nonspecific amplification,
11 and you thought, gee, since I am going to claim the
12 combination of target capture and PCR, why don't we
13 include something, just something, even a passing
14 reference to PCR in the specification. Didn't that
15 thought ever come to mind before you signed the
16 oath claiming that this was your application?

17 A. I guess not. I mean, I don't recall
18 making -- having that thought or telling anybody.

19 MR. SWINTON: No further questions.

20 MR. BANKS: I have nothing more.

21 THE VIDEOGRAPHER: Going off the video record
22 at 3:12 p.m. at the end of tape 3.

23 FURTHER DEPONENT SAITH NOT.

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